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EXAMINER

DAY, HERNG DER

ART UNIT	PAPER NUMBER
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2123

10

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,067

Applicant(s)

HARASAKI ET AL.

Examiner

Herng-der Day

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This communication is in response to Applicants' Amendment (paper # 7) to Office Action dated March 11, 2003 (paper # 6), mailed June 6, 2003.

1-1. Claims 1, 3, 10, 11, 14, 16, 18, 22, 24, 30-38, 42, 43, and 45-67 have been cancelled; claims 68-81 have been added; claims 68-81 are pending.

1-2. Claims 68-81 have been examined and claims 68-81 have been rejected.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

(a) S73, in Fig. 8.

3. The proposed drawing corrections to Fig. 34, filed June 6, 2003, have been approved. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is Applicants' responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

3-1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing

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the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

3-2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

Specification

4. The amended paragraphs in paper # 7 are objected to because of the following informalities. Appropriate correction is required.

4-1. It appears that "814", as described in line 1 of page 2, should be "S14".

4-2. It appears that "EXECUTING DATA", as described in lines 10-11 of page 2, should be "EXECUTING DATE".

Claim Objections

5. Applicants have cancelled claims 3, 14, 16, 18, 22, and 24. The original claim objections in paper # 6 have been withdrawn.

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Claim Rejections - 35 USC § 112

6. Applicants have cancelled claims 10-11, 14, 16, 31, 42, 55-62, and 64-67. The original claim rejections in paper # 6 under 35 U.S.C. 112, second paragraph, have been withdrawn.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 70 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8-1. Claim 70 recites the limitation “the original design watch” in lines 3-4 of the claim. There is insufficient antecedent basis for this limitation in the claim. For the purpose of claim examination, the Examiner will presume that “the original design watch” as described in the claim refers to “an original design watch”.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 68-72 and 74-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al., U.S. Patent 5,357,439 issued October 18, 1994, in view of d’Huart, U.S. Patent Des. 345,509 issued March 29, 1994.

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10-1. Regarding claims 68-69, 71-72, and 74-81, Matsuzaki et al. disclose an original product design creating method in a design creating system having a consumer terminal and maker-side host computer connected with the consumer terminal through an information communication network, the method comprising steps of:

(Claim 68) providing in the maker-side host computer (design department, FIG. 1), a product parts digital information indicating product constituent parts (design information, FIG. 1) and a design software (product design creating means 10, FIG. 1) to the consumer terminal (order window, column 5, lines 51-53);

receiving in the consumer terminal (order window, column 5, lines 51-53), the product parts digital information indicating product constituent parts (design information, FIG. 1) and the design software (product design creating means 10, FIG. 1) from the maker-side host computer (design department, FIG. 1);

creating in the consumer terminal, an original product design information (goods specification, FIG. 1) by using the design software to combine the product parts digital information (FIG. 8 and corresponding specification);

transmitting from the consumer terminal, the original product design information to the maker-side host computer (transmitted, column 12, lines 18-21); and

receiving in the maker-side host computer, the original product design information (transmitted, column 12, lines 18-21);

(Claim 69) acquiring in the consumer terminal, production status of a product according to the original product design information (state value, FIG. 1);

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(Claim 71) displaying in layers in the consumer terminal, a completed figure, pattern groups of product constituent parts, and designation of parts, on a screen of the consumer terminal by using the design software (FIG. 10);

(Claim 72) sequentially and selectively displaying on a screen of the consumer terminal from a large group to a small group of the product constituent parts by using the design software (the details of the item will be displayed, column 11, line 56, through column 12, line 1);

(Claim 74) displaying in the consumer terminal, a plurality of competed products to be compared with one another on the same screen of the consumer terminal by using the design software (resulting designs, column 11, lines 4-12; FIG. 9);

(Claim 75) selecting location, number, length, font and color of a dial-plate message on a screen of the consumer terminal by using the design software (graphic processing function, column 9, lines 10-41);

(Claim 76) displaying a plurality of sample patterns on the same screen of the consumer terminal by using the design software (enter into "photo corner" and show samples, FIG. 8);

(Claim 78) inputting in the consumer terminal, message information independently created by the consumer, and wherein the original product design information includes the message information (keyboard, column 9, lines 22-25);

(Claim 79) inputting in the consumer terminal, product design information independently created by the consumer, and wherein the original product design information includes the product design information (enter into "craft corner" and change outer appearance, FIG. 8);

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(Claim 80) the original product design information includes material information of the product constituent parts (the attribute includes material, column 16, line 57, through column 17, line 3);

(Claim 81) the original product design information includes mechanical function information of the product constituent parts (the attribute includes strength, column 16, line 57, through column 17, line 3).

Matsuzaki et al. fail to expressly disclose that the “product parts digital information” and the “original product design information” are respectively the “watch parts digital information” and the “original watch design information” indicating watch constituent parts and for creating watch design. Neither do Matsuzaki et al. expressly disclose any inherent information of the original watch design information.

d’Huart discloses an ornamental design for a wristwatch (d’Huart, claim). In other words, the watch design disclosed by d’Huart indicates what the necessary watch parts digital information indicating watch constituent parts and the original watch design information for creating watch design, such as, watch case information, buckle information, watch band information, hands information, dial-plate information, time indicator information, etc. (Claim 77), will be inherent.

In order to meet the customer’s own requirements for a watch and provide a method of implementing the design, selection, and ordering of such a watch, one of ordinary skill in the art of clock maker would be motivated to modify the teachings of Matsuzaki et al. to incorporate the inherent watch parts digital information indicates watch constituent parts and the original watch design information for creating watch design as disclosed by d’Huart. In other words, the

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combined teachings of Matsuzaki et al. and d'Huart enable the clock maker to produce a watch customized to the customer's own specifications.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Matsuzaki et al. to incorporate the teachings of d'Huart to obtain the invention as specified in claims 68-69, 71-72, and 74-81 because it enables the clock maker to produce a watch customized to the customer's own specifications in a highly efficient, commercially practical method.

10-2. Regarding claim 70, Matsuzaki et al. fail to expressly disclose confirming in the maker-side host computer, a color tone of an original design watch according to the original watch design information, although Matsuzaki et al. do provide design information using detail design CAD system based on customer requirement as shown in FIG. 1. Therefore, confirming color tone is implicitly provided because the combined teachings of Matsuzaki et al. and d'Huart enable the clock maker to confirm and produce a watch customized to the customer's own specifications which includes color tone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Matsuzaki et al. to incorporate the teachings of d'Huart to obtain the invention as specified in claim 70, because it enables the clock maker to confirm and produce a watch customized to the customer's own specifications in a highly efficient, commercially practical method.

11. Claims 71-74 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Matsuzaki et al., U.S. Patent 5,357,439 issued October 18, 1994, and d'Huart, U.S. Patent Des. 345,509 issued March 29, 1994 as applied to claim 68, and further in

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view of Maxey et al., "New Riders' Reference Guide to AutoCAD Release 13", New Riders Publishing, Indianapolis, Indiana, 1995.

11-1. Regarding claims 71-74 and 76, Matsuzaki et al. fail to expressly disclose displaying on a screen of the consumer terminal an enlarged view of an original design watch according to the original design watch information by using the design software. Nevertheless, Matsuzaki et al. suggest using CAD system to provide design information as shown in FIG. 1 and using graphic computer 1-22 which has a graphic processing function (column 9, lines 31-41).

In New Riders' Reference Guide to AutoCAD Release 13, Maxey et al. "document each command, along with every prompt and dialog box feature associated with that command" (introduction, page 2). Specifically, Maxey et al. disclose:

(Claim 71) displaying in layers in the consumer terminal, a completed figure, pattern groups of watch constituent parts, and designation of parts, on a screen of the consumer terminal by using the design software (LAYER, pages 369-373).

(Claim 72) sequentially and selectively displaying on a screen of the consumer terminal from a large group to a small group of the watch constituent parts by using the design software (DVIEW, pages 277-284).

(Claim 73) displaying on a screen of the consumer terminal an enlarged view of an original design watch according to the original design watch information by using the design software (ZOOM, pages 756-759).

(Claim 74) displaying in the consumer terminal, a plurality of competed watches to be compared with one another on the same screen of the consumer terminal by using the design software (MAKEPREVIEW, pages 401-402).

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(Claim 76) displaying a plurality of sample patterns on the same screen of the consumer terminal by using the design software (DVIEW, pages 277-284).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Matsuzaki et al. and d'Huart to incorporate the AutoCAD teachings of Maxey et al. to obtain the invention as specified in claims 71-74 and 76, as suggested by Matsuzaki et al.

Applicants' Arguments

12. Applicants cancel all the rejected claims and argue the following with respect to the newly added claims.

(1) "none of the cited references disclose or suggest a host computer providing digital information and design software, which creates an original design from the digital information, to a consumer terminal through an information communication network, as stated in new claim 68" (page 14, paper # 7).

(2) "none of the cited references disclose or suggest that the creation of an originally designed and unique watch" (page 14, paper # 7).

Response to Arguments

13. Applicants' arguments have been fully considered. They are not persuasive.

13-1. Applicants cancel all the claims rejected in paper # 6. Therefore, Applicants' arguments with respect to those cancelled claims are moot. In view of Applicants' unpersuasive arguments

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with respect to the newly added claims, claims 68-81 are rejected under 35 U.S.C. 103(a), as detailed in sections 7 to 11-1 above.

13-2. In response to Applicants' arguments (1) and (2) against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

14. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Herng-der Day whose telephone number is (703) 305-5269. The examiner can normally be reached on 9:00 - 17:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin J Teska can be reached on (703) 305-9704. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Herng-der Day
October 4, 2003


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100